WINSTON & STRAWN LLP

CLIENT ALERT

Scope of Analogous Art Depends on Whether It Is From the Same Field of Endeavor, or Is Reasonably Pertinent

NOVEMBER 25, 2020

Donner Technology, LLC v. Pro Stage Gear, LLC, No. 2020-1104 (Fed. Cir. Nov. 9, 2020)

This case considers the appropriate standard for determining if prior art is analogous for purposes of determining unpatentability. On *inter partes* review, the appellant challenged various claims of the appellee's patent (the '023 patent) as obvious under 35 U.S.C. § 103. Appellants argued that figures depicting an embodiment of another patent, Mullen, were analogous to the structure claimed by the appellee's patent. The Patent Trial and Appeal Board (PTAB) rejected the challenges based on the appellant's failure to prove that Mullen is analogous art. The appellant appealed, and the Federal Circuit vacated and remanded.

The Federal Circuit held that the PTAB applied the wrong standard for assessing whether Mullen was analogous art. The Federal Circuit explained that prior art includes all analogous art, with two separate tests defining the scope of analogous prior art: 1) whether the art is from the same field of endeavor, regardless of the problem addressed, and 2) if the reference is not within the field of the inventor's endeavor, whether the reference is still reasonably pertinent to the particular problem with which the inventor is involved. Because the '023 patent and Mullen are not from the same field of endeavor, the Court considered only whether Mullen could be reasonably pertinent to one or more of the particular problems addressed in the '023 patent.

The Federal Circuit noted that reasonable pertinence rests on the extent to which the relevant reference and the claimed invention relate to a similar problem or purpose, which must be compared from the perspective of a person having ordinary skill in the art (PHOSITA) who is considering turning to the teachings of references outside their field of endeavor. The PTAB erred by effectively collapsing the field-of-endeavor and reasonable-pertinence inquiries in its characterization of the '023 patent. The PTAB also failed to assess whether Mullen was reasonably pertinent to the same purpose or problem as the '023 patent. Nor did the PTAB address the *relevant* question, which is whether a PHOSITA would reasonably have consulted the reference in solving the relevant problem. Finally, the Federal Circuit noted that a reference can be analogous art with respect to a patent even if there are significant differences and that the PTAB did not explain its reliance on the age difference between the '023 patent and Mullen in concluding that a PHOSITA would not have turned to Mullen.

The Federal Circuit remanded for the PTAB to consider whether Mullen is analogous art under the proper standard.

Read the full decision here.

2 Min Read

Related Locations

Charlotte | Chicago | San Francisco | Silicon Valley

Related Topics

Patent Trial and Appeal Board (PTAB) | Patent Litigation | Prior Art

Related Capabilities

Patent Litigation | Intellectual Property

Related Regions

North America

Related Professionals

David Enzminger

Ivan Poullaos

Mike Rueckheim

Danielle Williams